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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,738	07/23/2001	Tomohiro Uchida	01436/LH	2686
1933	7590	06/15/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			LE, VU	
220 5TH AVE FL 16			ART UNIT	
NEW YORK, NY 10001-7708			PAPER NUMBER	
			2613	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,738

Applicant(s)

UCHIDA ET AL.

Examiner

Vu Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 23 and 29 are objected to because of the following informalities:

Claim 23 calls for the display section and the operation section are integrated as single device. It is unclear how applicants define "an integrated system" as claimed. However, it is noted that the disclosure e.g. fig. 16 shows a system comprising interconnecting of parts. For art rejection purpose, claim 23 is construed as a system comprising interconnecting display and operation sections.

Claim 29 calls for the operation section is operable to move the designated part of the observation image within the observation image. It is not understood how a designated part of the observation image is moved within itself. For art rejection purpose, claim 29 is construed as manipulating the portion of observed image via a microscope stage.

Clarification is requested.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus et al, US 6,226,392.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Re claim 22, Bacus discloses an imaging apparatus for a microscope (figs. 4A-4B, 5) comprising:

an imaging section to pick up an observation image formed by a microscope (fig. 4b: 126);

a display section which is separate from the imaging section for displaying the observation image picked up by the imaging section (fig. 5: 22); and

an operation section (figs. 4A-4B: 12,122,124) comprising:

dedicated shutter switch solely for causing the imaging section to pick the observation image (130 i.e. image acquisition electronics, it would have been obvious to one skilled in the art that 130 serves the substantial equivalent as a dedicated controls for acquisition of an image which would have necessitated causing the shutter of the imaging section 126 to pick up an observation image. Also, it is notoriously well known and obvious to one skilled in the art to acquire an image via a manual switch cause by a user for the benefit of user selectivity. Official Notice is taken),

a storage section storing the picked up observation image (62, also col. 8, line 34-38, col. 9, line 55-64),

a mode switching section switching the imaging apparatus between an imaging mode in which the observation image is picked up and displayed, and a reproducing mode in which the observation image stored in the storage section reproduced and displayed (Bacus teaches displaying the immediately acquired image-col. 8, line 59-62, or archiving the image for later analysis, displayed or analyzed immediately-col. 9, line 16-17. Although not specifically disclosed, it would have been obvious in Bacus to switch between an acquired image for immediate display and an archived image for reproduction display for the benefit of image analysis and comparison since both types of images are readily available. Official Notice is taken);

wherein the operation section is operable to manipulate observation image displayed by the display section (col. 8, line 59 – col. 9, line 17).

Re claim 23, the imaging apparatus according to claim 22, wherein the display section and the operation section are integrated as single device (It noted that “an integrated system”, defined by applicants’ disclosure e.g. fig. 16, shows interconnecting of parts. Hence, fig. 5 of Bacus shows the similar integrated system including interconnecting display and operation sections).

Re claim 24, the imaging apparatus according to claim 22 wherein the display section and the operation section are attachable to and detachable from each other (fig. 5 shows the operation section 12 i.e. computer interconnects with

the display 22. It would have been obvious and notoriously well known that the computer is attach/detachable from the display. Official Notice is taken).

Re claim 25, the imaging apparatus according to claim 22, wherein a display magnification for the observation image displayed by the display section is selectable by the operation section in at least one the imaging mode and the reproducing mode (figs. 1-3, col. 8, line 59 – col. 9, line 17, col. 11, line 13-23, in Bacus, the immediately acquired image and/or archived image may be displayed for analysis with capability of variable magnification selected by a user. The magnification is displayed as a Z-scale-fig. 3).

Re claim 26, the imaging apparatus according to claim 25, wherein the display magnification is displayed by the display section in at least one the imaging mode and the reproducing mode. (See claim 25).

Re claim 27, the imaging apparatus according to claim 25, wherein the observation image displayed by the display section in the reproducing mode is a central portion of the observation image stored in the storage section. (Figs. 1-3 of Bacus show a display screen displaying a list of tiled images of an entire macro image, and portion(s) of the tiled images may be selected for display. Hence, it would have been obvious in Bacus that a selected portion for display may be a central portion of an archived image as claimed).

Re claim 28, the imaging apparatus according to claim 25 wherein in the reproducing mode the operation section is operable to designate at least one part of the observation image and to cause the display section to display the

designated part of the observation image accordance with the selected display magnification. (See claims 25-27).

Re claim 29, the imaging apparatus according to claim 28, wherein in the reproducing mode, the operation section is operable to move the designated part of the observation image within the observation image. (See col. 9, line 35-64).

Re claim 30, the imaging apparatus according to claim 28 wherein in the reproducing mode, the operation section is operable to cause the display section to display an index indicating the part of the observation image. (Figs. 1-3, col. 32-45, in Bacus, the windows 24 as shown in fig. 2 defines an index scheme to prevent image overlapping and interference so that extensive image processing is avoided).

Re claim 31, the imaging apparatus according to claim 28, wherein in the reproducing mode, the at least one designated part of the observation image comprises a plurality of designated parts, and the operation section is operable to cause the display section to display the designated parts in list. (See claims 25-27 and 30. Also at col. 10, line 37-45. The tiled images are displayed-fig. 2 as a list).

Re claim 32, the imaging apparatus according to claim 31, wherein in the reproducing mode, the operation section is operable to cause the display section to display the designated parts in the list reduced scale. (See claims 25-27 and 30-31, also the displayed tiled images are at reduced scale-figs. 1-3).

Re claim 33, the imaging apparatus according to claim 31, wherein in the reproducing mode, the operation section is operable to cause the display section to display the designated parts in the list magnified in scale. (See claims 25-27 and 30-32, also portion(s) from the displayed list of tiled images may be selected for magnified view 26-figs. 1-3).

Re claim 34, the imaging apparatus according to claim 31, wherein in the reproducing mode, the operation section operable to cause the display section to display the designated parts in the list with the display magnification. (See claim 25).

Re claim 35, the imaging apparatus according to claim 22, wherein the operation section connectable a personal computer (fig. 5, col. 11, line 49-52).

Response to Arguments

4. Applicant's arguments with respect to claims 22-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Le whose telephone number is (571) 272-7332. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


VU LE
PRIMARY EXAMINER